

REMARKS

Claims 58 and 62 have been amended to change “down regulation” to “modification.”

This amendment is supported by the specification on page 17, lines 3-7.

In accordance with the previously issued restriction requirement, applicants have elected to prosecute claims 58, 60, 62 and 63 in this application. Non elected claims 1-26, 40-57, 59, 61 and 64-67 have been cancelled without prejudice or disclaimer.

The specification has been objected to because the first sentence of the specification does not include a sentence indicating whether the international application was published under PCT Article 21(2) in English. Applicants have amended the specification to include a sentence indicating that this is national phase of International Application No. PCT/AU98/00292, filed April 23, 1998, which was published under PCT Article 21(2) in English. Accordingly, this objection should be withdrawn.

Claim 63 is objected to as being an improper multiple dependent claim. Claim 60 has been amended to no longer be a multiple dependent claim. Since claim 63 no longer depends on any other multiple dependent claims, this objection should be withdrawn.

Claim 58 is objected to for reciting “or predisposition to prostate cancer” and “being predisposed to prostate cancer” as these phrases refer to non-elected subject matter. These two phrases have been deleted from claim 58, making this rejection moot.

Claim 60 is objected to for depending from claim 59, which is a non-elected claim. Claims 60 and 63 have been amended to no longer depend from claim 59. Accordingly, this rejection should be withdrawn.

Claims 58, 60 and 62 stand rejected under 35 USC 102(b) as being anticipated by Teni. This rejection is respectfully traversed. These claims are all directed to methods of screening for a mammal having prostate cancer comprising screening for modification to inhibin protein levels in the mammal. The Examiner states that Teni discloses a method for screening for prostate cancer comprising screening for the down-regulation of prostatic inhibin-like peptide levels in mammals wherein the down-regulation of the peptide is indicative of the mammal having developed prostate cancer. Teni only discusses measuring the level of the prostatic inhibin-like peptide (PIP). Teni does not disclose measuring inhibin protein levels as claimed by applicants.

The Examiner assumes that inhibin-like peptide (PIP) is the same as inhibin as defined by applicants--this assumption is erroneous. As stated clearly stated in Teni, PIP is inhibin-like and is not actually an inhibin. Further, attached is an article abstract of Gordon et al., *Beta-Microseminoprotein (Beta-MSP) Is Not an Inhibin* (1987) *Biol. Reproduction*, 36(4) 829-35 (1987). This article explicitly states that “ β -microsemenoprotein is not an inhibin.” Since claims 58, 60 and 62 only claim methods that include screening for inhibin protein levels, these claims are not anticipated by Teni. Accordingly, the rejection of claims 58, 60 and 62 as anticipated by Teni should be withdrawn.

Claims 58, 60, 62 and 63 stand rejected under 35 USC 103(a) as being unpatentable over Ying and Teni. It is the Examiner’s contention that it would have been obvious to “modulate the method of Ying et. al. so as to screen for prostate cancer using the specific polyclonal antibodies raised against α -inhibin since Teni et al. teach the successful screening of prostate cancer comprising screening for the down-regulation of inhibin protein levels.” See Office Action, page

7. As discussed above, the Examiner's reliance upon Teni as showing the successful screening of prostate cancer comprising screening for the down regulation of inhibin protein levels is erroneous because Teni does not disclose screening for an inhibin as claimed by applicants.

Since the screening for modification to inhibin protein levels in mammals as claimed by applicants is not taught by Teni or Yang alone or in combination, the rejection of claims 58, 60, 62 and 63 as being unpatentable over Ying and Teni should be withdrawn.

For the forgoing reasons allowance of the claims in this application is solicited.

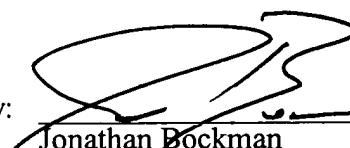
In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, Applicants petition for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to

Deposit Account No. 03-1952 reference Attorney Docket No. 229752000800.

Respectfully submitted,

Dated: September 26, 2002

By:


Jonathan Bockman
Registration No. 45,640

Morrison & Foerster LLP
1650 Tysons Blvd., Suite 300
McLean, VA 22012
Telephone: (703) 760-7769
Facsimile: (703) 760-7777

VERSION WITH MARKINGS TO SHOW CHANGES MADE

Please cancel claims 1-57, 59, and 64-67.

Please amend claims 58, 60 and 63 as follows:

58. (Amended) A method of screening for a mammal having prostate cancer or predisposition to prostate cancer, said method comprising screening for modification to the down regulation of inhibin protein levels in said mammal wherein modification the down regulation of said inhibin protein levels relative to the inhibin protein levels in a normal mammal is indicative of said mammal being predisposed to prostate cancer or having already developed prostate cancer.

60. (Amended) The method according to claim 58 or 59 wherein said inhibin is α -inhibin.

63. (Amended) The method according to claim 58 or 59 or 60 or 61 or 62 wherein said down regulation modification is absence absent.